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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/431,566	10/29/1999	LAURENCE WAYNE CLARKSON	7000-044	8874
27820	7590	04/04/2006	EXAMINER	
WITHROW & TERRANOVA, P.L.L.C.			PHAM, HUNG Q	
P.O. BOX 1287			ART UNIT	PAPER NUMBER
CARY, NC 27512			2168	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/431,566

Applicant(s)

CLARKSON ET AL.

Examiner

HUNG Q. PHAM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47,49-60 and 62-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47,50-54,57-60,63-66 and 69-72 is/are rejected.
- 7) ☒ Claim(s) 49,55,56,62,67 and 68 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 072104.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 07/21/2004 has been entered.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 07/21/2004 was filed before mailing of the first Office Action after the filing of a request for continued examination under § 1.114 on 07/21/04. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

Claim 49 is objected to because of the following informalities: *map audio identifiers of the audio segments to an offset and length of the audio segment within the audio package* (the claimed limitation should be amended to indicate each identifier corresponding to the offset and length of an audio segment within the package). Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 47 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (IV)(B)(2)(a):

Products may be either machines, manufactures, or compositions of matter.

A *machine* is "a concrete thing, consisting of parts or of certain devices and combinations of devices." *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

...

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911-12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

Instead of identifying the physical structure of the system in terms of its hardware or hardware and software combination, claim 47 directs to a system comprising software per se, e.g., *a centralized database comprising a plurality of audio segments, and an audio package builder/export tool*. Therefore, claim 47 is non-statutory.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As in claim 49, the clause *the audio segments* in the limitation *map audio identifiers of the audio segments*, and the clause *the audio segment within the audio package* reference to other items in claim 47. It is unclear what items are being referenced by these two clauses.

As in claim 54, the clause *said audio segment file* references to other items in claim 47. It is unclear what item is being referenced.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 47, 50-54, 57, 59, 60, 63-66, 69, 71 and 72 are rejected under 35 U.S.C. 102(a) as being anticipated by Cromwell [A Syntax For the MGCP Audio Package].

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Regarding claims 47 and 59, Cromwell teaches *a system for use in a telecommunications network for providing audio segments to a gateway to be played to an end user of the telecommunications network* (As disclosed at pages 1 and 2, MGCP Announcement Package that includes Play Announcement, Play Collect and Play Record is constituted for use by an Announcement Server Gateway and an External Call Agent (page 1)), *said system comprising:*

a centralized database comprising a plurality of audio segments, said audio segments comprising announcements to be played to the end user of the telecommunications network (As disclosed at page 4, Introduction, paragraphs 1 and 2, a complex audio structure consists of an announcement followed by voice variable followed by another announcement, e.g., "There are thirty seven minutes remaining on your prepaid calling card", where the number of minutes is a voice variable. A complex audio could be specified by provisioning the components on the Announcement Server as a single reference. As seen, the Announcement Server as *a centralized database comprising a plurality of audio segments, said audio segments comprising announcements to be played to the end user of the telecommunications network*);

an audio package builder/export tool adapted to' (The syntax as disclosed is *an audio package builder/export tool*):

¹ As set forth in MPEP 2111.04:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a "whereby" clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Id.* However, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a "whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited." *Id.*

Examiner respectfully suggests applicants replacing the "adapted to" clause by a positive statement that discloses the claimed invention.

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access the centralized database (As discussed above with respect to page 4, Introduction, Announcement Server as *the centralized database* is accessed to provision the announcement components by referencing);

construct an audio package from audio segments in the centralized database (As further disclosed at page 4, Introduction, paragraphs 3 and 4, an Announcement Server Package as *an audio package* is constructed from *audio segments* in Announcement Server);

construct an index file within the audio package that indicates to the gateway where in the audio package an audio segment may be located (As disclosed at page 4, "Section 2. Announcement Server Package", the Announcement Server Package is comprised of events. The event file is further disclosed at "Section 3. Events." In the event file, the symbol pl(parms) indicates component "Play Announcement" is a Provisioned Segment (page 6). A Provisioned Segment is referenced by id and possibly language to a provisioned sequence of recording (page 7, Provisioned Segment). A provisioned audio segment could be played in the default language S: pl (ps:5) (page 17). As seen, event file as *index file* is constructed within Announcement Server Package, and a referenced id indicates to the gateway where in the audio package an audio segment may be located);

construct a catalog file within the audio package, said catalog file comprising information selected from the group consisting of; announcement title, phrasing, prompt text, voice talent, language, codec, format, group, release notes, checkdata, and date recorded (As disclosed at "Section 2. Announcement Server Package", the Announcement Server Package is comprised of Parameters. As at page 6, Parameter file as *a catalog file within the audio package* is constructed consisting of announcement title, e.g., failure announcement, success announcement); and

export the audio package to the gateway (Pages 12 and 13, Section 5 and 6).

Regarding claims 50 and 63, Cromwell teaches all of the claimed subject matter as discussed above with respect to claims 47 and 59, Cromwell further discloses *audio package builder/export tool exports the audio package to the gateway over a packet based network* (Abstract, first paragraph).

Regarding claim 51, Cromwell teaches all of the claimed subject matter as discussed above with respect to claim 47, Cromwell further discloses *the system is adapted to² operate on a provisioning server* (Section 1 Introduction).

Regarding claims 52 and 64, Cromwell teaches all of the claimed subject matter as discussed above with respect to claims 47 and 59, Cromwell further discloses *each of said audio segments comprises a unique audio identifier* (page 7, Provisioned Segment).

Regarding claims 53 and 65, Cromwell teaches all of the claimed subject matter as discussed above with respect to claims 47 and 59, Cromwell further discloses *audio package builder/export tool is further adapted to³ present a graphical user interface to a user such that the user may select audio segments to be placed in the audio package* (Section 1 Introduction).

² See Footnote 1.

³ See Footnote 1.

Regarding claims 54 and 66, Cromwell teaches all of the claimed subject matter as discussed above with respect to claim 47, Cromwell further discloses *audio segments file comprises a subset of the audio segments in the centralized database* (Section 1 Introduction).

Regarding claims 57 and 69, Cromwell teaches all of the claimed subject matter as discussed above with respect to claims 47 and 59, and the technique of *preliminarily exporting the audio package to an intermediary storage location within a provisioning server* is an inherited feature because when building the announcement server package, the specified segment must be loaded into an intermediary storage location within a provisioning server, e.g., a cache.

Regarding claim 60, Cromwell teaches all of the claimed subject matter as discussed above with respect to claim 59, Cromwell further discloses the step of *provisioning the centralized database with audio segments* (Section 1 Introduction, second paragraph).

Regarding to claim 71, Cromwell teaches all the claimed subject matters as discussed in claim 47, Cromwell further discloses the purpose of exporting the audio package is to *selectively present the audio segments within the audio package to end users* (Examples of Section 7 Key Qualifiers).

Regarding to claim 72, Cromwell teaches all the claimed subject matters as discussed in claim 47, Cromwell further discloses *the index file is a distinctive data structure within the audio package* (Events File at page 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 58 and 70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cromwell [A Syntax For the MGCP Audio Package].

Regarding claims 58 and 70, Cromwell teaches all the claim subject matters as discussed above with respect to claims 47 and 59, but does not explicitly teach *audio package builder/export tool is further adapted to⁴ export the audio package to the gateway by exporting the audio package to a portable computer readable storage medium*. However, instead of storing the Announcement Server Package in Announcement Server Gateway, a portable computer readable storage medium, e.g., high capacity removable disk, can be used to store the package. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to export the Announcement Server Package to a high capacity removable disk in order to manually distribute the package to another gateway.

Allowable Subject Matter

Claims 49, 55, 56, 62, 67 and 68 are objected to as being dependent upon a rejected base claim, but would be allowable if corrected the informalities, conformed to 35 U.S.C. § 112 as indicated above and MPEP 2111.04 as indicated in Footnotes, and rewritten in independent form.


⁴ See Footnote 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q. PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TIM T. VO can be reached on 571-272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


HUNG Q PHAM
Examiner
Art Unit 2168

March 30, 2006